UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,658	01/23/2001	Jeremy A. Kenyon	41018.P009	3790

25943	7590	08/26/2004

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EXAMINER
NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 July 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to amendment dated June 24, 2004.

2.   Per Applicants' request, claims 6, 15 and 18 have been amended. Claims 1-24
remain pending.

Response to Amendment

3.   In view of Applicants' amendment to claims 6 and 18, the objection to these
claims is hereby withdrawn.

4.   In view of Applicants' amendment to claim 15, the rejection of this claim under
35 U.S.C. § 112, second paragraph is hereby withdrawn.

Response to Argument

5.   Applicant's arguments dated June 24, 2004 have been fully considered but they
are not persuasive. The rejection of claims 1-24 under 35 U.S.C. § 102(b) as being
anticipated by U.S. Patent No. 5,742,829 to Davis et al. al. ("Davis") is thus
maintained. Following is the examiner's response to Applicants' arguments.

Claim 1

Applicants' arguments:

> The software updating of the method recited in Claim 1 provides a type of software
> updates not taught or disclosed by *Davis*. In fact, the Applicants have been unable to
> identify anywhere within *Davis*, let alone the cited portions of *Davis*, where a task list is
> mentioned. In particular, *Davis* fails to teach "providing the client computer with an **update
> task list** listing one or more **tasks to be performed by the client computer**
> **asynchronously** at a later point or later points in time to update the client computer's
> software" (see also page 9, lines 13-20 for further examples). From this distinction alone, it
> is clear that the present invention, as recited Claim 1, is distinct from the teachings of *Davis*.

> *Davis* uses a server to schedule and push down updates. *Davis* is not a system for a client
> computer asynchronous updating software of a client computer as in the invention of Claim
> 1. The present invention, as recited in Claim 1, is directed to providing such a method of
> computing with updates performed at the client computer.
>
>   Thus, it is clear that *Davis* fails to teach the method of updating of the present
> invention. *Davis* merely teaches a method of scheduling at a server, that is distinct from the
> present invention as claimed in Claim 1.

Examiner's response:

In view of the U.S. Court of Customs and Patent Appeals holding that claims are to be given their broadest reasonable interpretation during the prosecution of a patent application. In re Pearson 494 F.2d 1399, 1403, 181 USPQ 641, (CCPA 11974) and for art rejection purposes, claimed element **server** is equated with **Site Server** 202 (Figure 3A) and claimed element **client computer** with **Client Server** 216 (Figure 3B).

According to the context provided by the preamble (i.e., **In a server**) and the claim language of the recited limitations in the body of Claim 1, it is understood that the two recited method steps are to be performed by a **server**, not by a client. Therefore, the Office action has cited the Scheduler 312 (Figure 3A) because it is understood that this scheduler schedules software update tasks to be performed by the Client Server (see Figure 3B, item SMSLS Batch File 352 which invokes Client Setup Executable 354 that install software onto the client computer).

Based on this interpretation, Davis appears to anticipate all the claimed elements of claim 1. The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Davis is considered to be proper and thus maintained.

Claims 8, 13 and 20

Since Claims 8, 13 and 20 contain similar claimed elements of Claim 1, the above discussion also applies to these claims.

Claims 2-7, 9-12, 14-19 and 21-24

Applicants' arguments:

> These claims include further recitations not taught, disclosed, or even suggested by *Davis*. For example, Claim 7 recites that the client computer will "retry one or more of the subsequent asynchronous requests for software parts." Applicants have been unable to identify anywhere in *Davis* where *Davis* teaches specifying retrying asynchronous requests. The cited portion of *Davis* (Figure 3A and related text) has no teaching of retrying any requests, let alone retrying asynchronous requests.

Examiner's response:

The feature of Claim 7 is anticipated by the inherent function of Davis' scheduler 312 in Figure 3A. As shown in 6:46-49, the scheduler 312 is responsible for scheduling software updates to occur across the distributed system and when the time has arrived for the update to be performed. It is thus logical that client server has to continue making request until the time has arrived for the update to be performed.

Accordingly, the rejection of Claims 2-7, 9-12, 14-19 and 21-24 under 35 U.S.C. § 102(b) as being anticipated by Davis is considered to be proper and thus maintained.

Claim Rejections – 35 U.S.C. § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,742,829 to Davis et al. al. ("Davis").

Claim 1

Davis discloses at least:

accepting check in by a client computer at a first point in time to determine if the client computer's software needs to be updated (see at least Figure 3B and related discussion in the specification); and

providing the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software is to be updated (see at least Figure 3B; Figure 3A, item 312; and related discussion in the specification).

Claim 8

Since claim 8 recites the same limitations of claim 1, the same rejection is therefore applied. Davis further discloses *performing said one or more tasks asynchronously at a later point or later points in time to update the client computer's software* (see at least Figure 3A, item 312 and related discussion in the specification).

Claim 13

Since claim 13 recites an apparatus comprising a storage medium that stores programming instructions executed by a processor to perform the same method steps recited in claim 1, the same rejection is therefore applied.

Claim 20

Since claim 20 recites a client computer comprising a storage medium that stores programming instructions executed by a processor to perform the same method steps recited in claim 1, the same rejection is therefore applied.

Claims 2 and 14

The rejection of base claims 1 and 13, respectively is incorporated. Davis further discloses *determining if the client computer's software needs to be updated* (see at least Figure 3B, item 354 and related discussion in the specification).

Claims 3, 9, 15 and 21

The rejection of the base claim is incorporated. Davis further discloses *re-contacting the server at a later point or later points in times to retrieve one or more software parts* (see at least Figure 3A, item 312 and related discussion in the specification).

Claims 4, 10, 16 and 22

The rejection of the base claim is incorporated. Davis further discloses *re-contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts* (see at least Figure 3A, item 312; Figure 2, items 212, 214, 202; and related discussion in the specification).

Claims 5, 11, 17 and 23

The rejection of the base claim is incorporated. Davis further discloses *one or more installation tasks to be performed asynchronously at a later point or later points in time upon*

asynchronously obtaining one or more software parts (see at least Figure 3A, item 312 and related discussion in the specification).

Claims 6 and 18

The rejection of the base claim is incorporated. Davis further discloses *servicing one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in the task list* (see at least 3B, item 340 and related discussion in the specification).

Claims 7 and 19

The rejection of the base claim is incorporated. Davis further discloses *asking the client computer to retry one or more of the subsequent asynchronous requests for software parts* (see at least Figure 3A, item 312 and related discussion in the specification).

Claims 12 and 24

The rejection of the base claim is incorporated. Davis further discloses *scheduling asynchronous performance of said tasks* (see at least Figure 3A, item 312 and related discussion in the specification).

Conclusion

8.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Antony Nguyen-Ba, whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday - Friday from 6:15 – 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Central Fax Number   (703) 872-9306

ANTONY NGUYEN-BA
PRIMARY EXAMINER
Art Unit 2122
August 20, 2004